

DAC  
JW

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT  
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)  
GERD:0461/YOD/SWA (RD25422-1)

First named inventor: Peter William Lorraine

Application No.: 10/747,739

Art Unit: 2856

Filed: December 29, 2003

Examiner: Surin, Jacques M. S.

Title: Method for Detection of Defects in Anisotropic Materials

Attention: Office of Petitions  
**Mail Stop Petition**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

**APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION**

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

**1. Petition fee**

☐ Small entity-fee \$ \_\_\_\_\_ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☒ Other than small entity - fee \$ 1,500.00 (37 CFR 1.17(m))

**Authorized to charge:**  
**Deposit Acct. No. 07-0868**  
**Order No. RD25422-1/YOD**

**2. Reply and/or fee**

A. The reply and/or fee to the above-noted Office action in the form of Petition Pursuant to 37 C.F.R. § 1.47 (identify type of reply):

- ☐ has been filed previously on \_\_\_\_\_.
- ☒ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$ 1,700.00

- ☒ has been paid previously on July 12, 2005.
- ☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

05/23/2006 MAILHED1 00000069 070868 10/47/33

1500.00 DA

01 FC:1453

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

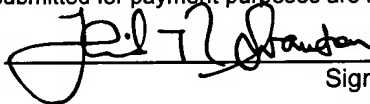
## 3. Terminal disclaimer with disclaimer fee

☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ \_\_\_\_\_ for a small entity or \$ \_\_\_\_\_ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

**WARNING:**

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.



Signature

May 18, 2006

Date

Tait R. Swanson

Typed or printed name

48, 226

Registration Number, if applicable

Post Office Box 692289

Address

(281) 970-4545

Telephone Number

Houston, Texas 77269-2289

Address

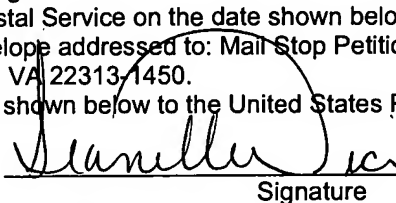
Enclosures: ☒ Fee Payment☒ Reply☐ Terminal Disclaimer Form☐ Additional sheets containing statements establishing unintentional delay☐ Other: \_\_\_\_\_**CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]**

I hereby certify that this correspondence is being:

☒ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office as (571) 273-8300.

May 18, 2006

Date



Signature

Seanelle Dice

Typed or printed name of person signing certificate



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:

Peter William Lorraine et al.

Serial No.: 10/747,739

Filed: December 29, 2003

For: Method for Detection of Defects in  
Anisotropic Materials

§  
§  
§  
§  
§  
§  
§  
§  
§  
§

Group Art Unit: 2856

Examiner: Surin, Jacques M. S.

Atty. Docket: GERD0461/YOD/SWA  
RD25422-1

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING  
37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below:

May 18, 2006  
Date

Seanelle Dice

Sir:

**RENEWED PETITION PURSUANT TO 37 C.F.R. § 1.47**

In response to the decision mailed on April 17, 2006, the Applicants hereby submit the present Renewed Petition in accordance with 37 C.F.R. § 1.47 and M.P.E.P. §§ 409.03(a), (d), and (e). We submit the present Renewed Petition as proof of unavailability on the part of Ronald Alan Kline to execute the Combined Declaration & Power of Attorney for the present application. In view of the decision mailed on April 17, 2006, we also submit a Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 C.F.R. § 1.137(b) concurrently with the present Renewed Petition. Pursuant to 37 C.F.R. §§ 1.47 and 1.17(g), please charge the requisite fee of \$200 for filing the present Renewed Petition to Deposit Account No. 07-0868, Order No. RD25422-1/YOD (GERD:0461).

In accordance with M.P.E.P. § 409.03(a), enclosed with the present petition is a copy of the previously filed Combined Declaration & Power of Attorney executed by all available inventors. *See* Exhibit A. One inventor, Ronald Alan Kline, has not executed this Combined Declaration & Power of Attorney.

In accordance with M.P.E.P. § 409.03(d), the pertinent facts are as follows. In March – June, 2004, Paul J. DiConza (Reg. No. 48,418) attempted to contact Ronald Alan Kline via mail and subsequent internet searches, as set forth in a previous Petition filed on June 30, 2004, in accordance with 37 C.F.R. § 1.47. A copy of the previous Petition is enclosed as Exhibit B. For example, as set forth in the previous petition, the application papers were sent to Ronald Alan Kline's last known address via Federal Express on March 3, 2004. Unfortunately, the Federal Express package was returned undeliverable as indicated by the note "move" across the FedEx Airbill, which is enclosed as Exhibit C.

On August 5, 2005, the Patent Office mailed a decision dismissing the previously filed petition. A copy of this decision is enclosed as Exhibit D. As explained on page 2, the decision states "the transmittal letter is not attached to evidence/demonstrate that the entire application (description, claims, abstract, drawings) was presented to the non-signing inventor Mr. Kline along with the oath or declaration." Exhibit D. Furthermore, the petition concludes by stating that the "record as it stands suggests the transmission of the entire application (description, claims, abstract and drawings), but references one or more documents not in evidence (e.g., the transmittal letter)." Exhibit D.

On February 2, 2006, the Patent Office mailed an Office Action, indicating that the application is in condition for allowance except for the lack of signature by one inventor, i.e., Ronald Alan Kline. Specifically, the Office Action stated:

This application is in condition for allowance except for the following formal matters:

The Oath/Declaration is defective because of the lack of signature of one of the inventors who refuses to sign or cannot be reached. Applicant is advised to refer to MPEP 37 CFR 1.47 regarding "Filing when an inventor refuses to sign and cannot be reached" and also to the detailed information discussed in the petition decision of 08/05/05.

Office Action mailed on February 2, 2006, page 2.

On February 15, 2006, we re-forwarded the entire set of application papers to Ronald Alan Kline at the last known address by certified mail. A copy of the transmittal

letter is attached as Exhibit E, and a copy of the certified mail receipt is attached as Exhibit F. As indicated in the transmittal letter, the set of application papers included (1) the original patent application filed in the Patent & Trademark Office, (2) the Figures that accompanied the application, (3) a Declaration, and (4) and Assignment. *See* Exhibit E. Unfortunately, the package was returned undeliverable as indicated by the enclosed copy of the envelope. *See* Exhibit G. Once again, after diligent effort, the inventor, Ronald Alan Kline, cannot be reached to review the application papers and execute the assignment and declaration documents.

In view of the undeliverable Federal Express attempt of March 3, 2004, the subsequent internet searches between March and June, 2004, and the recent undeliverable certified mail attempt of February 15, 2006, we believe that reasonable and diligent efforts have been made to reach the inventor, Ronald Alan Kline, in accordance with 37 C.F.R. § 1.47 and M.P.E.P. §§ 409.03(a) and (d). Therefore, it is our belief that Ronald Alan Kline is unavailable and/or refuses to execute the declaration for the present application.

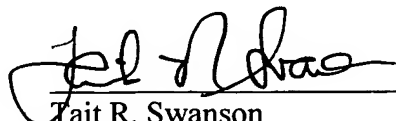
In accordance with M.P.E.P. § 409.03(e), the last known addresses for Ronald Alan Kline is:

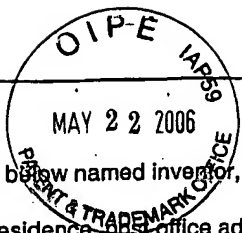
Home: 4408 St. Andrews Court  
Norman, Oklahoma 73072

Pursuant to 37 C.F.R. §1.47, then, the joining inventors hereby Petition to be permitted to prosecute the Application without the joinder of Ronald Alan Kline.

Respectfully submitted,

Date: May 18, 2006

  
\_\_\_\_\_  
Tait R. Swanson  
Registration No. 48,226  
FLETCHER YODER  
P.O. Box 692289  
Houston, TX 77269-2289  
(281) 970-4545



**EXHIBIT A**

Docket Number  
RD25422-1

**DECLARATION FOR PATENT APPLICATION**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:  
**METHOD FOR DETECTION OF DEFECTS IN ANISOTROPIC MATERIALS**

the specification of which is attached hereto unless the following box is checked:

☒ was filed on 12/29/03 as United States Application Number or PCT International Application Number 10/747,739  
and was amended on \_\_\_\_\_ (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations §1.56. I hereby claim foreign priority benefits under Title 35, United States Code, §119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed.

Prior <u>Foreign Application</u>			Priority Claimed
_____ (Number)	_____ (Country)	_____ (Day/Month/Year Filed)	<input type="checkbox"/> Yes <input type="checkbox"/> No
_____ (Number)	_____ (Country)	_____ (Day/Month/Year Filed)	<input type="checkbox"/> Yes <input type="checkbox"/> No

I hereby claim the benefit under Title 35, United States Code, §119(e) of any United States provisional application(s) listed below.

_____ (Application Number)	_____ (Filing Date)
_____ (Application Number)	_____ (Filing Date)

I hereby claim the benefit under Title 35, United States Code §120 of any United States Application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

_____ (Application Number)	_____ (Filing Date)	_____ (Status - patented, pending, abandoned)
_____ (Application Number)	_____ (Filing Date)	_____ (Status - patented, pending, abandoned)

I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith, **CUSTOMER NO. 006147.**

Paul J. DiConza, Reg. No. 48,418

Christian G. Cabou, Reg. No. 35,467, Donald S. Ingraham, Reg. No. 33,714, Patrick K. Patnode, Reg. No. 40,121, Henry J. Policinski, Reg. No. 26,621, James W. Mitchell, Reg. No. 25,602, Catherine J. Winter, Reg. No. 38,364, and Scott R. Hayden, Reg. No. 41,821.

Address all telephone calls to: Paul J. DiConza at telephone number (518) 387-6131

Address all correspondence to: **General Electric Company  
GRC Patent Docket Rm 4A59  
P.O. Box 8, Bldg. K-1  
Schenectady, New York 12301**

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

SOLE OR FIRST INVENTOR:

Full name: Peter William Lorraine

First Name

Middle Name

Last Name

Signature: Peter William Lorraine

Date

3/12/2004

Residence: Niskayuna, New York

City and State

Citizenship: USA

Post Office Address: 876 Heather Lane, Niskayuna, New York 12309

SECOND JOINT INVENTOR:

Full name: Ronald Alan Kline

First Name

Middle Name

Last Name

Signature: \_\_\_\_\_

Date

Residence: Norman, Oklahoma

City and State

Citizenship: USA

Post Office Address: 4408 St. Andrews Court, Norman, Oklahoma 73072

THIRD JOINT INVENTOR:

Full name: \_\_\_\_\_

First Name

Middle Name

Last Name

Signature: \_\_\_\_\_

Date

Residence: \_\_\_\_\_

City and State

Citizenship: \_\_\_\_\_

Post Office Address: \_\_\_\_\_

FOURTH JOINT INVENTOR:

Full name: \_\_\_\_\_

First Name

Middle Name

Last Name

Signature: \_\_\_\_\_

Date

Residence: \_\_\_\_\_

City and State

Citizenship: \_\_\_\_\_

Post Office Address: \_\_\_\_\_



## EXHIBIT B

RD-27885 25422-1

### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: P.W. Lorraine et al.  
Group Art Unit: 3662  
Serial No.: 10/064,618- 747,739  
Filed: December 29, 2003

#### PETITION UNDER 37 CFR §1.47(a)

Pursuant to 37 CFR §1.47(a), Applicants respectfully submit this petition to allow the subject application to be made by the signing joint inventor on behalf himself and Mr. Ronald Alan Kline, last known mailing address 4408 St. Andrews Court, Norman, Oklahoma 73072, a non-signing inventor who could not be found or reached after diligent effort.

Applicants respectfully submit that despite diligent efforts to locate Mr. Kline, Applicants have been unable to find him or otherwise contact him to execute the declaration and assignment for the subject patent application. On March 3, 2004, the application papers were sent to Mr. Kline's last known address via Federal Express. This last known address was taken from the GE Corporate inventor database and was separately confirmed by a telephone call to the Human Resources Department, GE Global Research. A copy of the air bill attached to the envelope containing the papers is enclosed in Attachment A herein. The unopened envelope was returned to GE some time later with the message "move" written across the air bill. Applicants then performed a search using various Internet-based directories, searching the state of Oklahoma for various combinations and permutations of Mr. Kline's full name and initials. The search was not successful. Moreover, Applicants contacted the three entries yielded for "Ronald A Kline" from a nationwide search on Yahoo's People Search web site, and none of these efforts produced contact with the inventor of the present application.

In light of Applicants diligent but fruitless efforts to contact Mr. Kline, as set forth above, Applicants respectfully request that the subject application be made by the signing co-inventor on behalf of himself and Mr. Kline.



Respectfully submitted,

Paul J. DiConza

Paul J. DiConza

Reg. No. 48, 418

General Electric Company

Building K1, Room 3A60

Schenectady, New York 12301

30 June 2004

Telephone: (518) 387-6131

Attachment: A

# EXHIBIT C

Inside  
air  
mail

**NO POUCH NEEDED.**  
See back for peel and stick application instructions.

451

1000

**FedEx. USA Airbill** 8384 1408 9648

Express

1 From This portion can be removed for Recipient's records.

Date 3/3/04

FedEx Tracking Number

838414089648

Sender's Name

Rita M. Lynch

Phone 518 387-5306

Company G E CORP RES & DEVEL CTR

Address 1 RESEARCH CIR BLDG K1

CITY NISKAYUNA

State NY

ZIP 12039

2 Your Internal Billing Reference

3 To

Recipient's Name RONALD ALAN KILGIE

Phone

Company

Address 4408 S. ANDREWS COURT

We cannot deliver to P.O. boxes or P.O. ZIP codes.

Address

CITY NORMAN

State OK

ZIP 73072

838414089648



0234640201

**FedEx.**

**PRIORITY OVERNIGHT**

emp: 339086 834R04

TRK# 8384 1408 9648

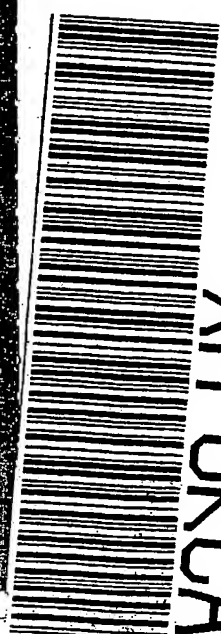
FORM 8215

012200714

73072 -OK-US

Deliver By: 04MAR04 A2

**XH OKCA**



Recipient's Copy

4a Express Package Service

☒ FedEx Priority Overnight

Next business morning

☐ FedEx Standard Overnight

Next business afternoon

☐ FedEx 2Day

Second business day

☐ FedEx Express Saver

Third business day

4b Express Freight Service

☐ FedEx 1Day Freight

Next business day

☐ FedEx 2Day Freight

Second business day

5 Packaging

☒ FedEx Envelope\*

Includes FedEx Small Flat, FedEx Large Flat, and FedEx Small Flat

☐ FedEx Pak\*

Includes FedEx Small Flat, FedEx Large Flat, and FedEx Small Flat

6 Special Handling

☐ SATELLITE DELIVERY

Deliver to satellite location

☐ HOLD Weekday

at FedEx location

☐ Signature Required

Signature required for delivery

☐ HOLD Saturday

at FedEx location

☐ Insure

Insure contents up to \$100,000

☐ Dry Ice

By air & UN 1845

☒ No

As per enclosed Shipper's Instructions

☐ Yes

Shrink Wrapping

7 Payment Bill to:

☒ Sender

Account No. in Section 1

☐ Recipient

Enter FedEx Acct. No. or Credit Card No. below:

8 Release Signature

☐ Third Party

Sign to authorize delivery without obtaining signature

☐ Credit Card

Account No.

447



# EXHIBIT D

UNITED STATES PATENT AND TRADEMARK OFFICE



GERD: 0461 YOD LS  
RD25422-1 PCPI  
Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

DOCKETED  
FOR 10/5/2005  
BY ~ 8/6  
CHECK'D BY (138)rc

JIGJR: 08-04

Paper No:     

GENERAL ELECTRIC COMPANY (PCPI)  
C/O FLETCHER YODER  
P.O BOX 692289  
HOUSTON TX 77269-2289

**COPY MAILED**

AUG 0 5 2005

**OFFICE OF PETITIONS**

In re Application of  
Lorraine, et al.  
Application No. 10/747,739  
Filed: 29 December, 2003  
Attorney Docket No. RD25422-1

ON PETITION

This is a decision on the petition filed (originally with an incorrect application number) on 6 July, 2004, under 37 C.F.R. §1.47(a).

The Office regrets the delay in addressing this matter.

For the reasons set forth below, the petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

## NOTES:

- (1) Any reply must include a renewed petition (and fee) must include a petition under 37 C.F.R. §1.47 and must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 C.F.R. §1.47";
- (2) Thereafter, there will be no further reconsideration of this matter.

## BACKGROUND

The record indicates:

**RECEIVED**

AUG 11 2005

**Fletcher Yoder**

- the instant application was filed on 29 December, 2003, without, *inter alia*, a fully executed oath/declaration;
- on 12 April, 2004, the Office mailed a Notice of Missing Parts indicating, *inter alia*, that a fully executed oath/declaration was required within two months;
- on 6 July, 2004, Petitioner filed the instant petition with, *inter alia*, a statement by Petitioner Paul J. DiConza (Reg. No. 48,418), along with an oath/declaration containing the signature of named co-inventor Lorraine (for himself and on behalf of) but without the signature of named non-signing co-inventor Ronald Alan Kline (Mr. Kline), a narration the statement of, and an averment that the oath or declaration was presented to Mr. Kline and references attached documents—however, while the attached assignment references (in hand note) a transmittal letter, the transmittal letter is not attached to evidence/demonstrate that the entire application (description, claims, abstract, drawings) was presented to the non-signing inventor Mr. Kline along with the oath or declaration;
- in advance of the mailing of this decision, a call was placed to Counsel on 4 August, 2005, and a copy of the letter will be provided when the petition is resubmitted.

#### ANALYSIS

The regulations at 37 C.F.R. §1.47 provide in pertinent part:

**§ 1.47 Filing when an inventor refuses to sign or cannot be reached.**

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

\* \* \*

The regulations at 37 C.F.R. §1.63 provide in pertinent part:

**§1.63 Oath or declaration.**

(b) In addition to meeting the requirements of paragraph (a) of this section, the oath or declaration must also:

- (1) Identify the application to which it is directed;
- (2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and
- (3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

When one alleges a refusal of the inventor to sign the application papers, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who, *inter alia*, presented the inventor with the application papers and/or to whom the refusal was made.

The commentary at MPEP §409.03(d) provides:

**409.03(d) Proof of Unavailability or Refusal**

**INVENTOR CANNOT BE REACHED**

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 C.F.R. §1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 C.F.R. §1.47.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 C.F.R. §1.47. 37 C.F.R. §1.43 may be available under these circumstances. See MPEP §409.02. Such a petition under 37 C.F.R. §1.47 will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached

should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

#### REFUSAL TO JOIN

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 C.F.R. §1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP §106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 C.F.R. §1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 C.F.R. §1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Thus, not only must a copy of the entire application must be sent to the last known address of the non-signing inventor (or the estate representative) with a request that he/she sign the declaration for the patent application—and evidence of that transmittal submitted—but also a reasonable effort must be made to ascertain a current or last known address, and the petition (with fee) must state over the signature and registration number of the Petitioner the last known address and, if appropriate, evidence of the due diligence effort ascertaining same.

Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented.

(The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47 applicant is required.<sup>1</sup>)

#### CONCLUSION

The record as it stands suggests the transmission of the entire application (description, claims, abstract and drawings), but references one or more documents not in evidence (e.g., the transmittal letter). The evidence of these requirements should be submitted with any renewed petition.

Out of an abundance of caution and because, *inter alia*, a property right is in question, Petitioner is requested to submit a copy of the transmittal letter with a renewed petition.

Therefore, the instant petition hereby is dismissed.

Further correspondence with respect to this matter should be addressed as follows:<sup>2</sup>

---

<sup>1</sup> See: MPEP 409.03(b).

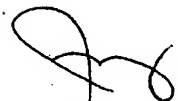
<sup>2</sup> On July 15, 2005, the Central Facsimile (FAX) Number will change from (703) 872-9306 to (571) 273-8300. Faxes sent to the old number will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and (571) 273-8300 will be the only facsimile number recognized for centralized delivery. (For further information, see: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf>.)

By mail: Commissioner for Patents<sup>3</sup>  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings  
(571) 273-8300  
ATTN.: Office of Petitions

By hand: Mail Stop: Petition  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

---

<sup>3</sup> To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at [www.uspto.gov](http://www.uspto.gov).



# EXHIBIT E

FLETCHER YODER



A Professional Corporation

Attorneys at Law

7915 FM 1960 West, Suite 330  
Houston, Texas 77070

Post Office Box 692289  
Houston, Texas 77269-2289

Telephone (281) 970-4545  
Facsimile (281) 970-4503



Writer's Extension: 110

Writer's E-Mail: yoder@fyiplaw.com

GERD:0461

RD25422-1

February 15, 2006

**CERTIFIED MAIL**  
**RETURN RECEIPT REQUESTED**

Mr. Ronald Alan Kline  
4408 St. Andrews Court  
Norman, Oklahoma 73072

Re: Patent Application for Review and Execution

Dear Mr. Kline:

As you may recall, at the time you left General Electric Global Research in late 2003, the referenced patent application had been prepared for an invention that you co-invented with Peter William Lorraine. It is our understanding that, briefly after filing the application, the original application and papers for your review and signature were sent to you by Ms. Rita Lynch of GE Global Research. However, the executed papers for filing in the Patent & Trademark Office were never received back from you.

In an effort to perfect execution of the necessary papers, we are respectfully re-forwarding the entire set of papers to you. These include:

1. The original patent application filed in the Patent & Trademark Office;
2. the Figures that accompanied the application;
3. a Declaration indicating that yourself and Mr. Lorraine were the original inventors of the claimed subject matter; and
4. an Assignment and Oath & Assignment of the invention to your former employer.

Please kindly look over the application and the remaining documents. While the application has been allowed, we need the signed Declaration and Assignment documents for filing in the Patent & Trademark Office. We have also enclosed a Federal Express envelope duly

FLETCHER YODER

CERTIFIED MAIL

RETURN RECEIPT REQUESTED

Mr. Ronald Alan Kline

February 15, 2006


Page 2

paid to facilitate the return of the Assignment and Declaration documents. Once the documents have been executed, kindly place them in the envelope and send the envelope back to me at the self-addressed location.

If we do not receive the documents from you within two weeks of mailing of this letter, we will file papers in the Patent & Trademark Office petitioning to proceed without your signature. However, we would certainly like to see you join in the application by signing the enclosed documents.

Should you have any questions or concerns whatsoever regarding the application or the documents enclosed with this letter, please do not hesitate to call me at (281) 970-4545. Thank you and we look forward to hearing from you in this matter.

Sincerely yours,

  
Patrick S. Yoder

PSY:lh  
Enclosure

**EXHIBIT F**

7002 0860 0006 3191 9069 161E

U.S. Postal Service  
**CERTIFIED MAIL RECEIPT**  
(Domestic Mail Only; No Insurance Coverage Provided)

**OFFICIAL USE**

Postage	\$ 2.31
Certified Fee	2.40
Return Receipt Fee (Endorsement Required)	1.85
Restricted Delivery Fee (Endorsement Required)	
Total Postage & Fees	\$ 6.56



Sent To Mr. Ronald Alan Kline  
Street, Apt. No.,  
or PO Box No. 4408 St. Andrews Ct.  
City, State, ZIP+4 Norman, OK 73072

PS Form 3800, April 2002 See Reverse for Instructions

EXHIBIT G

FIRST CLASS MAIL

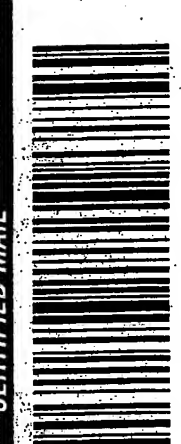


NR/27  
C 2/17/06  
ANK

MR. RONALD ALAN KLINE  
4408 ST. ANDREWS COURT  
NORMAN, OKLAHOMA 73072

NO SUCH NUMBER

NO SUCH NUMBER



7002 0860 0006 3191 6306

FLETCHER YODER  
PO BOX 692289  
HOUSTON, TEXAS 77269-2289

SENDER: COMPLETE THIS SECTION

1. Article Addressed to: Mr. Ronald Alan Kline  
4408 St. Andrews Court  
Norman, Oklahoma 73072

2. Article Number (Transfer from service label) 7002 0860 0006 3191 6306

3. Service Type  
☒ Certified Mail  
☐ Registered  
☐ Insured Mail  
☐ Return Receipt for Merchandise  
☐ Express Mail  
☐ C.O.D.

4. Restricted Delivery? (Extra Fee)  
☐ Yes  
☐ No

5. Signature X

6. Received by (Printed Name)  
C. Date of Delivery  
D. Is delivery address different from item 1? ☐ Yes ☐ No  
If YES, enter delivery address below:

PS Form 3811, August 2001  
102595-02-M-1035